



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/349,708	07/08/1999	CHARLES WILLIAM BERTHOUD	BERTHOUD-16-	7016

7590 03/31/2003
FARKAS & MANELLI PLLC
2000 M STREET NW
7TH FLOOR
WASHINGTON, DC 200363307

EXAMINER

BUI, BING Q

ART UNIT	PAPER NUMBER
----------	--------------

2642

DATE MAILED: 03/31/2003

164

Please find below and/or attached an Office communication concerning this application or proceeding.

T.

Office Action Summary

Application No.

09/349,708

Applicant(s)

Berthoud et al

Examiner

Bing Bui

Art Unit

2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 6, 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 2642

DETAILED ACTION

Response to Amendment

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 103

2. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smock et al (US Pat No. 6,377,668) in view of Bajzath et al (US Pat No. 6,144,644).

Regarding claim 1, with respect to Figure 1, Smock et al teach the invention as claimed, a system for notifying a called-but-busy party 16 of an incoming telephone call attempt over a telephone line while the called-but-busy party 16 is accessing the Internet over the same telephone line 50, comprising:

Internet communication module (Fig 1, element 68 and col 3, ln 8-34); and

a message formatter (Fig 1, element 64 and col 3, ln 66-col 4, ln 4);

wherein said Internet communication module is adapted to cause said message formatter to send a notification message (e.g. announcing the name and telephone number of the caller) to said called-but-busy party upon request from a caller (remote telephone user) (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22)..

Art Unit: 2642

Smock et al fail to teach the message sent to the called-but-busy party is a personalized notification recorded by a remote telephone user or caller. However, Bajzath et al teach if an internet user to whom a call is placed is not successful due to the internet user busy, the system offers the caller the ability to record a personal notification message for delivering to the internet user (see Fig. 6A, steps "600" through "660" and col. 6, Ins 7-53). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to integrate a personal notification message for the internet user recorded by the caller as taught by Bajzath et al into communication system of Smock et al in order to enable the busy-internet user to decide whether or not to be connected to the calling party.

Regarding claim 2, with respect to Figure 1, Smock et al teach the invention as claimed, an apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1 (Fig 1 and Abstract); Smock et al do not explicitly teach ,the remote telephone user is a central office; however, as it can be seen by an ordinary skill in the art, an incoming call transparently comes from a different or the same central office with the called-but-busy party via phone line 10 (Fig 1 and col 3, ln 8-45).

Regarding claim 3, with respect to Figure 1, Smock et al teach the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone

Art Unit: 2642

call attempt over a telephone line 50 while the called-but busy party is accessing the Internet over the same telephone line 50 according to claim 1, wherein said remote telephone user is a party trying to establish a telephone call with said called-but-busy party (Abstract; Fig 1 and col 2, ln 28-40).

Regarding claim 4, with respect to Figure 1, Smock et al teach the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, further comprising:

a call related information receiver 32 (Abstract; Fig 1; col 3, ln 39-45 and col 3, ln 66-col 4, ln 4);

wherein call related information regarding a calling party is included with said notification message (Abstract; Fig 1; col 3, ln 39-45 and col 3, ln 66-col 4, ln 4).

Regarding claim 5, with respect to Figure 1, Smock et al teach the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, wherein said call related information receiver is a Caller ID receiver (Abstract; Fig 1; col 3, ln 39-45 and col 3, ln 66-col 4, ln 4).

Regarding claims 6-7, 16 and 23, Bajzath et al further teach the notification message sent to an internet user and displayed on internet user's computer terminal

Art Unit: 2642

inherently in form of text (see Fig. 6A, steps "650"- "660" and col. 6, lns 33-41).

Regarding claim 8, with respect to Figure 1, Smock et al teach the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, further comprising said notification message includes an audibly playable data file (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22).

Regarding claim 9, with respect to Figure 1, Smock et al teach the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, wherein said audibly playable data file automatically plays when received on a computer terminal of said called-but-busy party (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22).

Regarding claim 10, with respect to Figure 1, Smock et al teach the invention as claimed, apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, further comprising: a data signal detector adapted to detect likely Internet usage of said called-but-busy party (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22).

Art Unit: 2642

Regarding claim 11, with respect to Figure 1, Smock et al teach the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 10, wherein said notification message includes information regarding likely Internet usage of said called-but-busy party (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22).

As to claims 12 and 18, they are rejected for the same reasons set forth to rejecting claim 1 above, since claims 12 and 18 are merely a method of operation for the system defined in the system claim 1.

Regarding claim 13, with respect to Figure 1, Smock et al teach the invention as claimed, the method for notifying a n Internet user of a telephone line that a calling party is attempting to connect with said Internet user according to claim 12, further comprising receiving a notification request from said calling party (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22).

Regarding claim 14, with respect to Figure 1, Smock et al teach the invention as claimed, the method for notifying a n Internet user of a telephone line that a calling party is attempting to connect with said Internet user according to claim 12, further comprising receiving a notification request from a central office (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22).

Art Unit: 2642

Regarding claim 15, with respect to Figure 1, Smock et al teach the invention as claimed, the method for notifying a n Internet user of a telephone line that a calling party is attempting to connect with said Internet user according to claim 12, further comprising determining at a central office a likelihood that said Internet user is connected with said Internet (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22).

Regarding claim 17, with respect to Figure 1, Smock et al teach the invention as claimed, the method for notifying a n Internet user of a telephone line that a calling party is attempting to connect with said Internet user according to claim 12, wherein said notification is an audibly playable message (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22).

As to claims 19-22 , they are rejected for the same reasons set forth to rejecting claims 12-15, respectively.

As to claim 24, it is rejected for the same reasons set forth to rejecting claim 8.

As to claim 25, it is rejected for the same reasons set forth to rejecting claim 1.

3. Claims 26-29, 32-36, 38-42 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smock et al (US Pat No. 6,377,668) in view of Berberich, Jr. et al (US Pat No. 5,818,919).

Regarding claim 26, with respect to Figure 1, Smock et al teach system for notifying a called-but-busy patty 16 of an incoming telephone call attempt over a

Art Unit: 2642

telephone line while the called-but-busy party 16 is accessing the Internet over the same telephone line 50, comprising:

a message formatter (Fig 1, element 64 and col 3, ln 66-col 4, ln 4) wherein an Internet communication module is adapted to cause said message formatter to send a notification message (e.g. announcing the name and telephone number of the caller) to said called-but-busy party upon request from a caller (remote telephone user) (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22).

Smock et al fail to teach a predetermined telephone number center adapted to receive a call from a caller with a desire to send a notification message to a called-but-busy party, and to cause said message formatter to send a notification message to said called-but-busy party upon request from a caller. However, Berberich, Jr. et al teach a predetermined telephone number platform such as voice messaging system that receives the caller's notification message for a called party while the called is busy on another call or provides no answer (col 4, ln 66-col 5, ln 26). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to integrate a predetermined telephone number platform such as voice messaging system as taught by Berberich, Jr. et al into communication system of Smock et al in order to quickly notify the called party that the caller has called him while he is busy on another call or provides no answer.

Art Unit: 2642

Regarding claim 27, with respect to Figure 1, Smock et al teach the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line 50 while the called-but busy party is accessing the Internet over the same telephone line 50 according to claim 1, wherein said remote telephone user is a party trying to establish a telephone call with said called-but-busy party (Abstract; Fig 1 and col 2, ln 28-40).

Regarding claim 28, with respect to Figure 1, Smock et al teach the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, further comprising:

a call related information receiver 32 (Abstract; Fig 1; col 3, ln 39-45 and col 3, ln 66-col 4, ln 4);

wherein call related information regarding a calling party is included with said notification message (Abstract; Fig 1; col 3, ln 39-45 and col 3, ln 66-col 4, ln 4).

Regarding claim 29, with respect to Figure 1, Smock et al teach the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, wherein said call related information receiver is a Caller ID receiver (Abstract; Fig 1; col 3, ln 39-45 and col 3, ln 66-col 4, ln 4).

Art Unit: 2642

Regarding claim 32, with respect to Figure 1, Smock et al teach the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, further comprising said notification message includes an audibly playable data file (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22).

As to claim 33, it is rejected for the same reasons set forth to rejecting claim 26 above, since claim 33 is merely a method of operation for the system defined in the system claim 26.

Regarding claim 34, with respect to Figure 1, Smock et al teach the invention as claimed, the method for notifying a n Internet user of a telephone line that a calling party is attempting to connect with said Internet user according to claim 12, further comprising receiving a notification request from said calling party (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22).

Regarding claim 35, with respect to Figure 1, Smock et al teach the invention as claimed, the method for notifying a n Internet user of a telephone line that a calling party is attempting to connect with said Internet user according to claim 12, further comprising receiving a notification request from a central office (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22).

Art Unit: 2642

Regarding claim 36, with respect to Figure 1, Smock et al teach the invention as claimed, the method for notifying a n Internet user of a telephone line that a calling party is attempting to connect with said Internet user according to claim 12, further comprising determining at a central office a likelihood that said Internet user is connected with said Internet (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22).

Regarding claim 38, with respect to Figure 1, Smock et al teach the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, further comprising said notification message includes an audibly playable data file (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22).

As to claims 39- 42 and 44 , they are rejected for the same reasons set forth to rejecting claims 26.

4. Claims 30-31, 37 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smock et al (US Pat No. 6,377,668) in view of Berberich, Jr. et al (US Pat No. 5,818,919), and further in view of Bajzath et al (US Pat No. 6,144,644).

Regarding claims 30-31, 37 and 43, the combination of Smock et al and Berberich, Jr. et al teaches the invention substantially as claimed, with the exception of providing notification message is a textual message. However, Bajzath et al teach the

Art Unit: 2642

notification message sent to an internet user and displayed on internet user's computer terminal inherently in form of text (see Fig. 6A, steps "650"- "660" and col. 6, lns 33-41). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify a method and system for notifying an on-going internet user an incoming call in form of e-mail, as taught by Bajzath et al, into communication system of Smock et al and Berberich, Jr. et al in order to provide the called party a flexible way in recognizing the content of the notification.

Response to Arguments

5. Applicant's arguments with respect to claims 1-25, 30-31, 37 and 39-44 have been considered but are moot in view of the new ground(s) of rejection.

6. Applicant's arguments filed 3/06/03 have been fully considered but they are not persuasive.

Regarding claims 26-29, 32-36 and 38:

(1) "Voice messaging system" in Berberich, Jr reads on claimed "call center" because the voice messaging system is a center for receiving incoming calls and messages for a plurality of voice messaging system subscribers and forwards one of the received messages to a corresponding subscriber.

Art Unit: 2642

(2) Predetermined telephone number associated with voice messaging system in Berberich, Jr reads on claimed predetermined telephone number specially designated for a center.

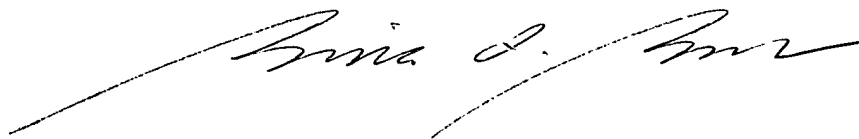
For above reasons, Examiner's ground of rejection with Berberich, Jr is maintained.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bing Bui whose telephone number is (703) 308-5858. The examiner can normally be reached on Monday through Thursday from 7:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314 and for formal communications intended for entry (please label the response "EXPEDITED PROCEDURE") or for informal or draft communications not intended for entry (please label the response "PROPOSED" or "DRAFT").

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Mar 24, 2003

A handwritten signature in black ink, appearing to read "Bing Bui", is written over a horizontal line.